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No. 82-775

In the

Supreme Court of the United States

OCTOBER TERM, 1982

GREEN BAY PACKAGING INC., ST. VINCENT HOSPITAL, and LEO N. CROWLEY,

Petitioners,

v.

TECHNICON MEDICAL INFORMATION SYSTEMS CORP.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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There are no parent, subsidiary, or affiliate companies of petitioner Green Bay Packaging Inc.

QUESTION PRESENTED

Whether the acts of

(1) affixing to certain documents a statutory notice of copyright including the prescribed year date of first publication, pursuant to the 1909 Copyright Act and the Universal Copyright Convention, and

(2) publishing the documents,

estop the party who affixed the notice and published the documents from subsequently asserting that such documents have not been generally published as represented by the copyright notice, but instead contain subject matter which is "trade secret."

PARTIES TO THE PROCEEDING BELOW

The plaintiff-appellee below is Technicon Medical Information Systems Corp. The defendants-appellants below are Green Bay Packaging Inc., St. Vincent Hospital, and Leo N. Crowley.

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OPINIONS BELOW

The opinion of the United States Court of Appeals for the Seventh Circuit (App. 1 to 13) is reported at 687 F.2d 1032 (7th Cir. 1982). The opinion of the United States District Court for the Eastern District of Wisconsin (App. 22 to 34) is reported at 211 U.S.P.Q. (BNA) 343 (E.D. Wis. 1980).

JURISDICTION

The United States Court of Appeals for the Seventh Circuit issued its opinion and entered its judgment on August 30, 1982. Rehearing was not requested. Petitioners invoke the jurisdiction of this Court pursuant to 28 U.S.C. § 1254(1) (1976).

STATUTORY PROVISIONS INVOLVED

United States Code, appendix to Title 17 (1909 Copyright Act):

> § 10. Publication Of Work With Notice
>
> Any person entitled thereto by this title may secure copyright for his work by publication thereof with the notice of copyright required by this title; and such notice shall be affixed to each copy thereof published or offered for sale in the United States by authority of the copyright proprietor. . . .
>
> § 19. Notice; Form
>
> The notice of copyright required by section 10 of this title shall consist either of the word "Copyright", the abbreviation "Copr.", or the symbol ©, accompanied by the name of the copyright proprietor, and if the work be a printed literary, musical, or dramatic work, the notice shall include also the year in which the copyright was secured by publication.
>
> § 26. Terms Defined
>
> In the interpretation and construction of this title "the date of publication" shall in the case of a work of which copies are reproduced for sale or distribution be held to be the earliest date when copies of the first authorized edition were placed on sale, sold, or publicly distributed by the proprietor of the copyright or under his authority. . . .

TREATY PROVISIONS INVOLVED

Universal Copyright Convention (Paris Text):

Article III

1. Any Contracting State which, under its domestic law, requires as a condition of copyright, compliance with formalities such as deposit, registration, notice, notarial certificates, payment of fees or manufacture or publication in that Contracting State, shall regard these requirements as satisfied with respect to all works protected in accordance with this Convention and first published outside its territory and the author of which is not one of its nationals, if from the time of the first publication all the copies of the work published with the authority of the author or other copyright proprietor bear the symbol © accompanied by the name of the copyright proprietor and the year of first publication placed in such manner and location as to give reasonable notice of claim of copyright.

Article VI

"Publication," as used in this Convention, means the reproduction in tangible form and the general distribution to the public of copies of a work from which it can be read or otherwise visually perceived.

STATEMENT OF THE CASE

I. INTRODUCTORY STATEMENT

This case presents a question of great importance, which has vexed those asserting and defending against alleged trade secret rights for at least the past 70 years, but which has never been addressed by this Court. At issue is the meaning of statutory notice of copyright, and whether one who uses such a notice is bound by what it represents to the public. The decision of the Seventh Circuit Court of Appeals permits a per-

son to affix a copyright notice on a document to invoke statutory rights and the resulting chilling effect on competition, and then subsequently to deny that any publication of the document took place when that person affixing the notice sues his competitor for trade secret misappropriation and copyright infringement.

The Seventh Circuit decision condones disregard for federal statutory copyright law and encourages suppression of legal competition. It also facilitates baseless trade secret litigation. The question presented here has prompted grave concern among lawyers and the public, particularly those in the computer industry. Moreover, legal and business commentators have vigorously disputed the proper approach to its resolution.

Also, the Seventh Circuit decision ignored the effect of the Universal Copyright Convention, effectively permitting misuse of a copyright notice prescribed by an international treaty duly ratified by the United States. This Court's guidance is needed to insure that the U. S. Copyright Law and the Universal Copyright Convention treaty provisions will not be misused to the public detriment through misleading use of copyright notice.

II. FACTUAL BACKGROUND

Respondent, Technicon Medical Information Systems Corp. ("TMIS"), commenced this action alleging that petitioners, Green Bay Packaging Inc. ("Green Bay"), St. Vincent Hospital, and Leo N. Crowley, misappropriated alleged TMIS trade secrets relating to computer "software" (computer programs) for hospital business management services. Petitioners have denied misappropriation, and have counterclaimed for antitrust violations.

Pursuant to a contract between TMIS and its predecessor, on the one hand, and Green Bay, on the other hand, Green Bay made its computer "hardware" available so that data processing services could be provided to certain Wisconsin hospital customers of TMIS. For some time prior to that contract, and during its pendency, St. Vincent Hospital gratuitously contributed its knowledge and experience to improve the TMIS computerized hospital management system. The TMIS contract with St. Vincent Hospital had no provision requiring that St. Vincent Hospital treat any material conveyed by TMIS as secret.

While St. Vincent Hospital was a customer of TMIS, it received printed computer manual publications. The TMIS "Technical Publications" department distributed numerous copies of these publications to more than 40 hospital customers, such as St. Vincent Hospital, and to others. The occurrence of at least a "limited" publication is not in dispute. Nevertheless, TMIS now contends that these publications contain trade secrets.

TMIS affixed the statutory copyright notice prescribed by the 1909 Copyright Act[1] (17 U.S.C. §§ 10, 19, and 26 (1976)), as well as a "proprietary legend" (quoted at 687 F.2d at 1033 n.1; App. 2), to the publications that it distributed. Under both the 1909 Copyright Act and the Universal Copyright Convention, the copyright notice

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[1] Each copyright notice contained the internationally recognized symbol "©" pursuant to the 1909 Copyright Act and the Universal Copyright Convention, followed by the name of the copyright proprietor, "Technicon Medical Information Systems Corp.," and by a year-date of publication (687 F.2d at 1033; App. 2). The printed Court of Appeals opinion contains a typographical error: "©" is reproduced as "(c)".

which TMIS affixed to the publications signifies that there was a publication in a specific year. Nevertheless, TMIS asserted in courts below that the publication of its manuals did not destroy its trade secrets.

III. THE PROCEEDINGS BELOW

A. The District Court Proceeding

In an effort to dispose of this entire trade secret and copyright controversy expeditiously, petitoners filed a motion for summary judgment on the above-quoted controlling issue of law. The TMIS Complaint as originally filed included both common law copyright and trade secret counts. Petitioners' motion sought an order estopping TMIS from claiming that its software publications, which it had earlier represented by a statutory copyright notice to be published works, instead are unpublished documents subject to both trade secret and common law copyright protection.

The District Court agreed with petitioners that, through its copyright notice, TMIS had invoked statutory copyright protection, and thereby had waived any common law copyright protection. The District Court therefore dismissed the seventh count of the Complaint—TMIS' common law copyright count (App. 28).

The District Court, however, rejected petitioners' argument that publication with a statutory copyright notice estops the owner from asserting trade secret misappropriation. Petitioners thereafter moved for interlocutory appeal pursuant to 28 U.S.C. § 1292(b) (1976), based upon the important and controlling question of law set forth above. The District Court granted the motion and certified the above-quoted controlling question of

law for appeal in its January 26, 1981 order (App. 18-21; reported in Copyright L. Rep. (CCH) ¶25,261 (E.D. Wis. 1981).

B. The Seventh Circuit Court of Appeals Decision

The Seventh Circuit granted petitioners' request for appeal under 28 U.S.C. § 1292(b) on March 6, 1981 (App. 16-17), heard oral argument, and rendered its judgment and opinion on August 30, 1982, answering the above-quoted controlling question of law in the *negative* (687 F.2d at 1039; App. 13).

In deciding the copyright estoppel question, the Court of Appeals enumerated three requirements for the doctrine of statutory estoppel utilized by this Court in *Exchange Trust Co.* v. *Drainage Dist. No. 7*, 278 U.S. 421, 425 (1929):

> (1) assertion by a party of entitlement to statutory right or privilege;
>
> (2) the receipt by that party of an actual benefit pursuant to the statute; and,
>
> (3) subsequent assertion by that party which is inconsistent with entitlement to the statutory benefit previously received. [687 F.2d at 1034; App. 4.]

While admitting that the first requirement was satisfied, the Court of Appeals held that the second was not, stating that TMIS did not receive any actual benefit from placing statutory copyright notice on its computer publications. The Court did not reach the third factor.

The Seventh Circuit therefore answered the certified question in the negative, giving no weight to the actual benefits received by TMIS—the copyright proprietor's property rights in the expression of the work which are assignable and licensable for valuable consideration. Neither did the Court of Appeals consider the demonstrated fact that the general public, upon seeing a copyright notice, recognizes that the copyright proprietor claims rights in the work under the U.S. Copyright Law and the Universal Copyright Convention.

REASONS FOR GRANTING THE WRIT

I. THE IMPORTANT QUESTION PRESENTED URGENTLY NEEDS RESOLUTION BY THIS COURT

A. Statutory Copyright Notice On A Publication Tells the Public That The Contents Are Not Secret

The question posed in this case strikes right at the heart of the inherent conflict between the two alternative systems for protecting certain intellectual property: federal copyright law and state trade secret law. Trade secret law protects the ideas and information in a secret document; copyright law protects only the published *form of expression* of those ideas and information. *Compare Kewanee Oil Co.* v. *Bicron Corp.*, 416 U.S. 470 (1974) *with Goldstein* v. *California*, 412 U.S. 546 (1973). Therefore, the public may make "open and free" use of the ideas and information disclosed in the copyrighted work[2] as long as it does not copy the form of

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[2] As cogently stated by one court:

> [T]he public is not free to use the invention described in a patent, but *it is privileged to use whatever information is imparted in a copyrighted book* about any system, art or manufacture described in it; furthermore . . . such a use is a consideration the public receives for the grant of the copyright. [Emphasis added]

Aldrich v. *Remington Rand, Inc.*, 52 F. Supp. 732, 734 (N.D. Tex. 1942). *Accord, Data Cash Sys.* v. *J S & A Group, Inc.*, 628 F.2d 1038, 1043 (7th Cir. 1980); *Crume* v. *Pacific Mutual Life Insurance Co.*, 140 F.2d 182, 183, *cert. denied*, 322 U.S. 755 (1944). *National Comics Publications, Inc.* v. *Fawcett Publications, Inc.*, 191 F.2d 594, 600 (2d Cir. 1951).

expression without authorization. 17 U.S.C. § 1 (1976).[3] *See Baker* v. *Selden*, 101 U.S. 99, 104 (1879); *National Comics Publications, Inc.* v. *Fawcett Publications, Inc.*, 191 F.2d 594, 600 (2d Cir. 1951); *Letter Edged in Black Press, Inc.* v. *Public Building Comm'n of Chicago*, 320 F. Supp. 1303, 1308 (N.D. Ill. 1970).

The statutory copyright notice tells the public that the document bearing the notice has been published on a certain date by the copyright proprietor. By way of example, the TMIS manuals distributed during and after 1974 bear the following statutory notice:

"© Technicon Medical Information Systems Corp., 1974"

Such statutory notice under the 1909 Copyright Act (17 U.S.C. §§ 10, 19 (1976)), and the Universal Copyright Convention (art. III, ¶1 and art. VI (Paris Text), *reprinted in* 4 M. NIMMER, NIMMER ON COPYRIGHT app. 25, at 25-2 and 25-13 (1982)), must include the year of first publication (1974). The symbol "©" invokes the benefit of the Universal Copyright Convention in addition to the protection of the U.S. Copyright Laws. The name of the copyright proprietor, "Technicon Medical Information Systems Corp.," is also included. See 17 U.S.C. §19 (1976).

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[3] While the provisions of the 1909 Copyright Act, and not the new 1976 Copyright Act, are at issue here, this question presented will continue to be raised, if unresolved by this Court, because the 1909 Copyright Act is still relevant for "undertakings commenced before January 1, 1978." 687 F.2d at 1034 n.4; App. at 2. *See* 17 U.S.C. § 301(b)(2) (Supp. IV 1980).

Thus, statutory copyright notice unequivocally represents that the document containing the notice has been published and therefore the contents are not "secret."[4]

B. Unless This Court Resolves The Question, Confusion About Proper Use Of And Reliance Upon Statutory Copyright Notice Will Plague The Public And The Courts

The inconsistency of placing statutory copyright notice on allegedly secret documents and then distributing the documents is not a theoretical problem. The public relies heavily upon statutory copyright notice for what it says.[5] For example, sixty-one percent of those industries surveyed by a Congressional subcommittee in 1959 reported *day-to-day reliance* on copyright notices to learn of a claim of copyright protection, to identify the copyright owner, and to determine the publication date. REPORTS OF SUBCOMMITTEE OF PATENTS, TRADEMARKS AND COPYRIGHTS OF THE U.S. SENATE COMMITTEE ON THE JUDICIARY, *reprinted in* STUDIES ON COPYRIGHT 275, 281 (Arthur Fisher mem. ed. 1963).

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[4] If TMIS or some other party attempting to protect alleged trade secrets wished to mark a short notice on unpublished documents similar to the statutory copyright notice for published documents, the following has been suggested in the 1980 ABA Committee Reports, Section of Patent, Trademark and Copyright Law 211, 219 (presented at the annual meeting, August 1-5, 1980):

"Unpublished—All Rights Reserved
Under The Copyright Laws."

[5] Even if there were no reliance by the public, the Court of Appeals agreed that the statutory estoppel doctrine could be applicable if the three requirements were met. 687 F.2d at 1034; App. 3.

Moreover, of the libraries responding to the survey, ninety-eight percent relied upon copyright notices, and at least some librarians considered copyright notice "as a protection of the public against misrepresentation of the content, much as the labeling requirements of the Pure Food and Drug Act . . . protect the public in the use of such products." *Id.* at 319, 321. Because there is such widespread reliance on statutory copyright notice, guidance from this Court is sorely needed to explain that the public can rely upon the notice for what it says: the contents of the documents bearing the notice are *not* secret.[8]

The uncertainty in this area is so great that for several years, committees of the American Bar Association Section of Patent, Trademark and Copyright Law have debated this issue, with committee members disagreeing over the proper resolution of the problem. *See* 1982 ABA COMMITTEE REPORTS, SECTION OF PATENT, TRADEMARK AND COPYRIGHT LAW 135, 139 (presented at the annual meeting, August 6-11, 1982) ("1982 ABA Report"); 1981 ABA COMMITTEE REPORTS, SECTION OF PATENT, TRADEMARK AND COPYRIGHT LAW 91, 93 (presented at the annual meeting, August 7-12, 1981) ("1981

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[8] As further evidence of how confusing this area can be, at least one federal agency has found it necessary to "legislate" administratively a solution to this dilemma. The National Aeronautics and Space Administration (NASA) has promulgated a regulation which states that affixing a copyright notice on a work submitted to NASA is *conclusive proof* that the work has been *generally published*, regardless of the presence of a proprietary legend, and that trade secret protection is *not* available for the information contained in the work. 41 C.F.R. ch. 18, § 9.203-4 (g) (iv), at 9-2:19 (1982). *See also* 41 C.F.R. ch. 18, § 9.203-4(a) at 9-2:17 (1982).

ABA Report"); 1980 ABA COMMITTEE REPORTS, SECTION OF PATENT, TRADEMARK AND COPYRIGHT LAW 211, 218-19 (presented at the annual meeting, August 1-5, 1980) ("1980 ABA Report"). As stated in the 1981 ABA Report:

> Lawyers continue to be plagued by the uncertainty of the interplay between state trade secret law and federal copyright protection. *This is especially evident in connection with the practice of marking trade secret documents with a copyright notice and date of publication, done in the belief that this gives remedies and protection under the state trade secret and the federal copyright laws.* In the event trade secret protection fails, it is hoped, federal copyright protection will be available and date back to the original publication date affixed to the documents . . . .
>
> • • • •
>
> It can also be argued that affixing the copyright notice and date of publication to a work estops the owner to deny that publication has occurred or to assert a secret in the contents of the work. See *Green Bay Packaging, Inc.* v. *Technicon Medical Information Systems Corp.*, Misc. No. 81-8004 (7th Cir. hearing granted March 6, 1981). [1981 ABA Report at 91, 93; emphasis added.]

The importance of the question is also suggested by the spate of recent cases involving related issues which skirt, but have not fully addressed, the question.[7] Legal

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[7] *E.g.*, *Bryce & Assoc.* v. *Gladstone*, 107 Wis. 2d 241, 319 N.W.2d 907 (Ct. App. 1982), *cert. denied*, 51 U.S.L.W. 3304 (U.S. Oct. 18, 1982) (No. 82-340); *Warrington Assoc.* v. *Real Time Eng. Systems, Inc.*, 522 F. Supp. 367 (N.D. Ill. 1981); *Avco Corp.* v. *Precision Air Parts, Inc.*, 210 U.S.P.Q. (BNA) 894 (M.D. Ala. 1980), *aff'd on other grounds*, 676 F.2d 494 (11th Cir. 1982); *Mitchell*

and business commentators recognizing the immense legal and practical significance of the question presented have puzzled over this very case and the inconsistency between statutory copyright notice on a document and subsequent assertion of trade secrets in the document. *E.g.*, Luccarelli, *The Supremacy of Federal Copyright Law Over State Trade Secret Law for Copyrightable Computer Programs Marked with a Copyright Notice*, III COMPUTER L.J. 19, 49 (1981); Schmidt, *Legal Proprietary Interests in Computer Programs: The American Experience*, 21 JURIMETRICS J. 345, 397 (1981).[7]

The question presented herein is not only of vital importance to the computer software industry, but also touches virtually every industry and profession in the

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[7] (Continued)

v. *Penton/Industrial Publishing Co.*, 486 F. Supp. 22, 24-26 (N.D. Ohio 1979); *Management Science America Inc.* v. *Cyborg Systems, Inc.*, 6 Computer L. Serv. Rep. (Callaghan) 921 (N.D. Ill. 1978).

[8] Other articles relating to this issue include: Comment, *Protecting Trade Secrets Through Copyright*, 1981 DUKE L.J. 981, 990, 997; Keplinger, *Computer Software—Its Nature and Its Protection*, 30 EMORY L.J. 483, 505 (1981); Nimtz, *Development of the Law of Computer Software Protection*, 61 J. PAT. OFF. SOC'Y 3, 20-21 (1979); *See also*, Bigelow, *Is There Legal Protection For Software?*, Infosystems, March 1980, at 104; Brickman, *Copyright Act Endangers Trade Secret Status*, Information Systems News, December 14, 1981, at 30; Brickman, *Trade Secrets* v. *Copyright Protection*, Information Systems News, May 18, 1981, at 27; Goetz, *At Stake: Competition, Growth, Survival*, Computerworld, September 10, 1979, at ID/15, ID/20-23; Greguras, *A New Look at Patentability*, Mini-Micro Systems, June 1981, at 161; Kuhn and Ball, *Protecting Software With Copyrights, Patents and Trade Secrets*, Journal of Systems Management, December 1978, at 28, 30.

United States exposed to copyrightable documents. If this Court ignores this problem, it leaves the area charted with but two uncertain and conflicting markers—the Seventh Circuit opinion below, and the contrary opinion of *Larrowe-Louisette* v. *O'Loughlin*, 88 F. 896 (S.D.N.Y. 1898), which give little guidance to the general public.[9]

The overriding public concern at stake here is whether statutory copyright notice has any meaning at all. Unless this Court intervenes, the Court of Appeals decision

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[9] This Court's guidance is also needed to provide standards for interpreting the requirement of "benefit" in the Supreme Court doctrine of statutory estoppel. While the Court of Appeals was unable to find "actual benefit" in the chilling effect of the notice as a deterrent, such a deterrent has been sufficient for many years to invoke the statutory estoppel of "patent marking estoppel." According to that doctrine, a manufacturer who marks a United States patent number on a product pursuant to the statutory notice provided by 35 U.S.C. § 287 (1976) is estopped to deny that the product infringes the patent. *See, e.g., Gridiron Steel Co.* v. *Jones & Laughlin Steel Corp.*, 361 F.2d 791, 797 (6th Cir. 1966); *Collis Co.* v. *Consolidated Machine Tool Corp.*, 41 F.2d 641, 645 (8th Cir. 1930), *cert. denied*, 282 U.S. 886 (1930); *Kant-Skore Piston Co.* v. *Sinclair Mfg. Corp.*, 32 F.2d 882, 885 (6th Cir. 1929), *cert. denied*, 281 U.S. 735 (1930); *Piaget Novelty Co.* v. *Headley*, 108 F. 870, 872-873 (2d Cir. 1901); *Crane Co.* v. *Aeroquip Corp.*, 364 F. Supp. 547, 560, 561 (N.D. Ill. 1973), *modified on other grounds*, 504 F.2d 1086 (7th Cir. 1974); *Kraly* v. *National Distillers and Chemical Corp.*, 173 U.S.P.Q. (BNA) 56, 59 (N.D. Ill. 1972); *Canaan Products, Inc.* v. *Edward Don & Co.*, 273 F. Supp. 492, 502 (N.D. Ill. 1966), *aff'd*, 388 F.2d 540 (7th Cir. 1968); *Touchett* v. *E Z Painter Corp.*, 150 F. Supp. 384, 391 (E.D. Wis. 1957); *Dwight & Lloyd Sintering Co.* v. *American Ore Reclamation Co.*, 44 F. Supp. 401, 402-403 (S.D.N.Y. 1941); *Lathrop* v. *Rice & Adams Corp.*, 17 F. Supp. 622, 626 (W.D.N.Y. 1936).

will permit misuse of the statutory copyright notice to mislead the public and to jeopardize fair and honest competition.

II. THE COURT OF APPEALS DECISION CONFLICTS WITH THE UNIVERSAL COPYRIGHT CONVENTION TREATY

The Court of Appeals completely overlooked the effect of the Universal Copyright Convention. By using the recognized symbol "©", TMIS has invoked the Universal Copyright Convention, which as of 1980 was signed by 73 countries. The Universal Copyright Convention provides that works protected in a member state will also be afforded the protection under the particular laws of each member. Universal Copyright Convention art. II (Paris Text), *reprinted in* 4 M. NIMMER, *supra*, app. 25, at 25-1 to 25-2. The primary purpose of the United States participation in this Convention was to provide a more adequate basis than had previously existed for copyright protection abroad of cultural and scientific works of United States citizens. H.R. REP. No. 2608, 83d Cong., 2d Sess. 2 (1954).

The Universal Copyright Convention prescribes a copyright notice similar to U.S. copyright notice including a "year of first publication." "Publication" is defined as "the reproduction of tangible form and the general distribution to the public of copies of a work . . . ." Universal Copyright Convention art. III, ¶1 and art. VI (Paris Text), *reprinted in* 4 M. NIMMER, *supra*, app. 25 at 25-2 and 25-13.

In fact, in the Universal Copyright Convention, "publication" is "one of the key words in the Convention .... If it were interpreted differently by the various contracting countries, this would lead to confusion in respect to almost the whole Convention." A. Bogsch, Universal Copyright Convention 81 (1958). Since under the Universal Copyright Convention the copyright notice signifies and is recognized by all member countries as *signifying that the work has been published in the year represented in the notice and is entitled to the benefit of the Convention,* it is inappropriate for the courts of any member nation to permit its nationals to make use of the internationally recognized notice without holding its nationals to the representations or consequences of such notice.

Thus, if for no other reason, this Court should review the Court of Appeals decision for its effect in weakening the Universal Copyright Convention by permitting cavalier use of copyright notice containing the symbol "©".

CONCLUSION

For these reasons, this Court should issue a writ of *certiorari* to the United States Court of Appeals for the Seventh Circuit to review the judgment and opinion of that Court.

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